

REMARKS/ARGUMENTS

Claims 1 – 3, 5 – 9, and 11 – 27 are presented for consideration. Additionally, Figure 1 and Figure 5 are presented for consideration. The Examiner previously objected to the drawings as failing to depict the ball and detent structure as disclosed in the description. Figure 1 and Figure 5 have been amended to satisfy the objection.

The Examiner objected to the presented Claims 1 – 10, 12 – 14, and 16 - 21 under 35 U.S.C. §102(b) as being anticipated by Bofill as the principal reference. Applicant respectfully traverses the Examiner's rejections to the claims as follows.

Claim 1 and Claim 21 have been rejected under 35 U.S.C. §102(b) as being anticipated by Bofill. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Bofill teaches the use of engagement assembly having an extension segment bracket to extend the position of a gas cartridge from the base of the paintball marker. Most importantly, Bofill teaches the use of the elongated extension segment places the gas cartridge in a position relative to the paintball marker which enhances the balance of the paintball marker providing “better maneuverability and handling.” Bofill, Col. 4, Lines 40 - 44. As currently amended, claim 1 and claim 21 improve upon the teachings of Bofill by removing the extension segment and providing an ergonomic dove-tail attachment positioning the gas cartridge substantially proximate to the base of the frame of the paintball marker to provide greater balance for the paintball marker. As will be appreciated by those skilled in the art, the fully charged gas cartridge used with the

Appl. No. 10/815,553
Amendment dated 6/12/06

paintball marker can be of considerable weight, and therefore, it is necessary to properly balance and position the weight of the cartridge with that of the paintball marker to provide greater maneuverability and handling. The close proximity of the gas cartridge and the frame of the paintball marker of Applicant's invention allows for a tighter, ergonomic assembly of the marker and gas cartridge. This assembly allows for greater range of motion for a marker user as well as adequate support for the weight of the gas cartridge. In contrast, the extension of the attachment of Bofill as shown and described must position a gas cartridge substantially distant from the paintball marker extending the weight of the marker/cartridge assembly downward. This assembly creates an unwieldy marker assembly in which the weight of the assembly is not adequately supported during the use of the marker. Additionally, the positioning of the gas cartridge substantially proximate to the frame of the marker to balance the marker teaches away from the teachings of Bofill which place the gas cartridge lower to balance the paintball marker. Further, the placement of the gas cartridge substantially proximate to the frame of the paintball marker positions the gas cartridge in line with the firing arm of the paintball player rather than below the player's arm as in Bofill. This placement provides an advantage to the player as the cartridge can be more readily supported in this position than in the extended position of Bofill. Further, the extension segment of Bofill as shown and described inherently creates an attachment which is prominent between the air cartridge and the marker. With this prominent assembly, the attachment of Bofill cannot be considered low-profile. As will be appreciated by those skilled in the art, the game of paintball is tactical and a low-profile presence is necessary to avoid being marked. If a paintball marker is unwieldy or obtrusive, the player will not function as well in the

Appl. No. 10/815,553
Amendment dated 6/12/06

game. Thus, there is need in the art to provide a discreet attachment for an air canister which provides an ergonomic design.

The prior art of Bofill inherently does not teach the positioning of the air canister substantially proximate to the base of the frame of the paintball marker. Therefore, Bofill is inappropriate as §102 references for the amended claim 1 as it does not show every element of the claimed invention. Thus, Bofill does not show, claim, or teach the limitation requiring the attachment position of the air tank “substantially proximate” to the paintball marker frame as required by Claim 1 and Claim 21. Claims 2 – 3, 5 – 9, and 11 – 20 are dependent from Claim 1 so that they also include this limitation that makes them distinguishable over Bofill. For a 35 U.S.C. 102(b) rejection, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, because Bofill does not teach or disclose every aspect of the claimed invention either implicitly or explicitly, the Claims 1 – 3, 5 – 9 and 11 – 21 of the present invention are patentably distinguishable over Bofill. Thus, Applicant respectfully requests that the rejection of Claims 1 – 3, 5 – 9 and 11 – 21 under 35 U.S.C. §102(b) be withdrawn.

The Examiner further rejected Claims 15 and 22 – 27 under 35 U.S.C. 103(a) as being unpatentable over Bofill in view of Goff et al. Claim 1 and Claim 22 have been amended to transverse this rejection. As mentioned above, Bofill fails to teach the use of an attachment placing the gas canister substantially proximate to the frame of the paintball marker. The combination of the ball and detent structure of Goff et al. and the prominent attachment assembly

Appl. No. 10/815,553
Amendment dated 6/12/06

of Bofill fail to teach an attachment assembly positioning the air tank substantially proximate to the paintball marker to provide an ergonomic assembly as disclosed by Applicant. As stated previously, the claims of Applicant's invention are expressly drawn and limited to an attachment assembly having discreet parts which position the air tank substantially proximate to the paintball marker. Neither the prior art cited by the Examiner nor the hypothetical combination of Goff et al. and Bofill teach positioning the air tank substantially proximate to the paintball marker.

Further, it is improper to combine references without a teaching, motivation, or suggestion found in the prior art for combining the references. As noted by the substantial authority covered in MPEP § 2145, § 2143.01, and the decisions of the Federal Circuit, it is improper to use the present application as a means for suggestion for combining the prior art references. No cited references showing a motivation for a 'skill in the art' combination or any reference with a 'means of suggestion' has been cited for combining any of these patents. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01 (*citing In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references, nor does the Examiner make specific findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or other findings to support a proper obviousness analysis. See *In Re Dembiczak*, 50 U.S.P.Q. 1614, 1618 (Fed. Cir.

Appl. No. 10/815,553
Amendment dated 6/12/06

1999). Because it is improper to use the present application as a means for suggestion for combining the prior art, Applicant respectfully requests claims 15 and 22 – 27 be allowed for issuance.

Applicant respectfully believes that this Amendment resolves all notwithstanding issues and earnestly solicits a telephone conference to expeditiously resolve any subsequent issues. Applicant respectfully believes that the amendments have addressed the Examiner's issues and believes the newly amended claims are ready for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,


Keisling Pieper & Scott, PLC
Meredith K. Lowry, Reg. No. 58,422
1 East Center Street, Suite 217
Fayetteville, AR 72701
Attorneys for Applicant
Tel: 479-251-0800
Fax: 479-251-0801

Appl. No. 10/815,553
Amendment dated 6/12/06

Amendment to the Drawings:

Applicant respectfully submits replacement sheets of drawings for Figures 1 – 6. Both Figure 1 and Figure 5 have been modified to label the ball and detent structure 88 as described in the specification.